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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,718	10/23/2000	James D. Bennett	YO998-100RA	2739

7590 06/05/2002
John H Sherman Legal Dept
Intermec Technologies Corp
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EXAMINER
FUREMAN, JARED
ART UNIT
PAPER NUMBER

2876

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,718

Applicant(s)

BENNETT, JAMES D. *Mc*

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Receipt is acknowledged of the amendment filed on 2/26/2002, which has been entered in the file. Claims 33-57 are pending. As Applicant's have now shown common ownership between the present invention and Wiklof et al (US 6,056,199), Wiklof et al is now applied in a double patenting rejection below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 37 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 37 and 46 recite an automatic backup circuit that initiates a communication between the second processing circuit and the second information tag if the information is not generated within a predetermined interval of time. However, claims 33 and 42, from which claims 37 and 46 depend, respectively, require that the second processing circuit utilizes the information to communicate with the second tag. It is unclear as to how the automatic backup circuit could initiate communication with the second information tag if the information, which is required to communicate with the second information tag, has not been generated. This renders the claims indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 33-36, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz et al (US 5,979,758, previously cited).

Swartz et al teaches a device (10) that reads a plurality of information tags, the device comprising: an antenna (106), a first processing circuit (the bar code reading circuit) that generates information from a first information tag (bar code symbol 103), a second processing circuit (105), coupled to the antenna, that utilizes the information (a valid bar code symbol must be decoded before the second processing circuit will actuate the antenna) to communicate with a second information tag (the EAS portion of the tag 101), wherein the second information tag is of a different type than the first information tag, wherein the first information tag is an optical target, the second information tag is a radio tag, and the first processing circuit generates the information from an image of the first information tag, wherein the optical target is an optical bar code (103), a manual selector switch (76) that, depending upon a setting, individually enables or disables the first processing circuit and the second processing circuit, wherein the information comprises identification data (the bar code contains information that identifies the article associated with the bar code and EAS tag) corresponding to

the second information tag (see figure 1, column 5 line 31 - column 8 line 36, column 9 line 61 - column 11 line 42).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 42-45, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al.

The teachings of Swartz et al have been discussed above. Swartz teaches the first and second tag being disposed on an article (102) (see figure 1).

Swartz et al fails to specifically teach a temporary carrier unit for storing articles of commerce, a plurality of goods stored on the carrier unit, the first and second information tags being disposed on the carrier unit.

However, Official Notice is taken that at the time of the invention it was well known to those of ordinary skill in the art to provide a temporary carrier unit (for example: a box) for storing articles of commerce, a plurality of goods stored on the carrier unit (for example: a box containing a plurality of goods), an information tag being disposed on the carrier unit (for example: a box having a bar code and/or EAS tag).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Swartz et al, a temporary carrier unit for storing articles of commerce, a plurality of goods stored on the carrier

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unit, the first and second information tags being disposed on the carrier unit, in order to allow efficient storage and transport of articles by placing several articles in a common container, rather than store/transport each article individually.

8. Claims 38 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al as in view of Blanford (US 4,679,154, previously cited).

The teachings of Swartz et al have been discussed above.

Swartz et al fails to teach a corruption detection circuit coupled to the first processing circuit that signals the first processing circuit to generate new information when the corruption detection circuit detects that the information is corrupt.

Blanford teaches a reader device (20) that includes a first processing circuit (bar code scanning circuit) for reading an information tag (a bar code), a corruption detection circuit (within microprocessor 82) coupled to the first processing circuit that signals the first processing circuit to generate new information when the corruption detection circuit detects that the information is corrupt (a bad read or invalid barcode data) (see figures 4, 6, column 2 lines 31-36, and column 5 line 45 - column 6 line 13).

In view of Blanford's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Swartz et al, a corruption detection circuit coupled to the first processing circuit that signals the first processing circuit to generate new information when the corruption detection circuit detects that the information is corrupt, in order to provide the user with an indication that the first information tag was not read/decoded properly, thereby, indicating the first information tag should be read again or the first information tag is defective.

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9. Claims 40 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al in view of Schmutz et al (US 5,633,487, previously cited).

Swartz et al fails to teach the information comprising location data corresponding to the second information tag.

Schmutz et al teaches an information tag comprising location data (destination) for a carrier unit (parcel) (see column 1 lines 9-21).

In view of Schmutz et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Swartz et al, the information comprising location data corresponding to the second information tag (in that the destination defines the destination location of the carrier unit and corresponding information tags), in order to place the destination location information in a machine readable format, thereby reducing shipping/delivery errors.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 33-35, 42-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 29-32 of U.S. Patent No. 6,056,199 (hereinafter the '199 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The '199 patent claims a device (a reader) that reads a plurality of information tags, the device comprising: an antenna (since the memory device is formed as an RF tag, the reader necessarily includes an antenna), a first processing circuit (a reading portion for reading the symbol) that generates information from a first information tag (a symbol), a second processing circuit (transmitter and receiver), coupled to the antenna, that utilizes the information to communicate with a second information tag (the memory device), wherein the first information tag is an optical target, the second information tag is a radio tag, and the first processing circuit generates the information from an image of the first information tag, wherein the second information tag is of a different type than the first information tag, wherein the optical target is an optical bar code, a temporary carrier unit (container) for storing articles of commerce (items), a plurality of goods stored on the carrier unit (see claims 1, 2, 4, 29-32).

12. Claims 38 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,056,199 (hereinafter the '199 patent) in view of Blanford.

The '199 patent fails to claim a corruption detection circuit coupled to the first processing circuit that signals the first processing circuit to generate new information when the corruption detection circuit detects that the information is corrupt.

Blanford teaches a reader device (20) that includes a first processing circuit (bar code scanning circuit) for reading an information tag (a bar code), a corruption detection circuit (within microprocessor 82) coupled to the first processing circuit that signals the first processing circuit to generate new information when the corruption detection circuit detects that the information is corrupt (a bad read or invalid barcode data) (see figures 4, 6, column 2 lines 31-36, and column 5 line 45 - column 6 line 13).

In view of Blanford's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to claim, in the '199 patent, a corruption detection circuit coupled to the first processing circuit that signals the first processing circuit to generate new information when the corruption detection circuit detects that the information is corrupt, in order to provide the user with an indication that the first information tag was not read/decoded properly, thereby, indicating the first information tag should be read again or the first information tag is defective.

13. Claims 40 and 49 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,056,199 (hereinafter the '199 patent) in view of Schmutz et al.

The '199 patent fails to claim the information comprising location data corresponding to the second information tag.

Schmutz et al teaches an information tag comprising location data (destination) for a carrier unit (parcel) (see column 1 lines 9-21).

In view of Schmutz et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to claim, in the '199 patent, the

information comprising location data corresponding to the second information tag (in that the destination defines the destination location of the carrier unit and corresponding information tags), in order to place the destination location information in a machine readable format, thereby reducing shipping/delivery errors.

14. Claims 41, 50-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, and 29-32 of U.S. Patent No. 6,056,199 (hereinafter the '199 patent) in view of Miura (US 6,036,348, previously cited).

The '199 patent fails to claim the data sets being a destination of the goods and an inventory of the goods, receiving status information corresponding to the carrier unit from the second information tag.

Miura teaches an information tag (3) which stores a plurality of data sets associated with goods associated with the information tag, the data sets including a destination of the goods (address, name, telephone number of the consignee) and an inventory of the goods (contents of the parcel 2) (see figure 1, column 3 lines 34-40, and column 4 lines 27-37).

In view of Miura's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to claim, in the '199 patent, the data sets being a destination of the goods and an inventory of the goods, receiving status information corresponding to the carrier unit from the second information tag, in order to provide the destination and inventory of the carrier unit in a machine readable form, thereby

increasing carrier unit delivery efficiency and reducing carrier unit delivery errors (see column 6 lines 50-55).

15. Claim 57 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-32 of U.S. Patent No. 6,056,199 (hereinafter the '199 patent) in view of Cato (US 5,874,724, previously cited).

The '199 patent fails to teach communicating with the second information tag via a base station.

Cato teaches an information tag (104) which communicates with a base station (120) (see figure 1 and column 1 lines 13-20).

In view of Cato's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to claim, in the '199 patent, communicating with the second information tag via a base stations, in order to allow the second information tag to communicate directly with a base station, thereby alleviating the need for the user to later transfer information from the reader device to the base station/host computer.

Allowable Subject Matter

16. Claims 41 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable (upon the filing of a terminal disclaimer) if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 51-57 would be allowable upon the filing of a terminal disclaimer.

18. The following is a statement of reasons for the indication of allowable subject matter: While Miura (US 6,036,348, previously cited) teaches an information tag (3)

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which stores a plurality of data sets associated with goods associated with the information tag, the data sets including a destination of the goods (address, name, telephone number of the consignee) and an inventory of the goods (contents of the parcel 2) (see figure 1, column 3 lines 34-40, and column 4 lines 27-37), the information tag 3, as taught by Miura, is an electronic memory device, whereas the second information tag as taught by Swartz et al is an EAS tag. The EAS tag can only provide a signal when activated and does not store a plurality of data sets. There is no motivation (without the benefit of Applicant's teaching) for one of ordinary skill in the art at the time of the invention to substitute the information tag as taught by Miura for the second information tag as taught by Swartz et al, due to the different structures and functions of the two information tags, and the different operations of the systems as taught by Swartz et al and Miura.

Thus, the prior art of record, taken alone or in combination fails to teach or fairly suggest: the second information tag storing a plurality of data sets, receiving status information corresponding to a carrier unit from the second information tag, in combination with the other claimed limitations as set forth in the claims.

Eberhardt (US 5,382,784) teaches a reader device which includes a bar code reader and an RF tag reader. However, Eberhardt teaches using the two separate readers independently, the information read from a bar code is not utilized to read an RF tag (see figures 2, 3f, 4, column 2 line 43 - column 4 line 68).

Response to Arguments

19. Applicant's arguments with respect to claims 33-57 have been considered but are moot in view of the new ground(s) of rejection.

As recited in the rejection above, Swartz et al teaches a device that communicates with a plurality of information tags.

As Applicant's have now shown common ownership between the present invention and Wiklof et al (US 6,056,199), Wiklof et al is now applied in a double patenting rejection.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brick et al (US 6,269,342 B1), Halperin (US 6,318,631 B1), Ross et al (US 6,332,098 B2), Hook et al (US 2001/0054005 A1) all teach reading devices for reading bar codes and radio frequency tags.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jared J. Fureman
Jared J. Fureman
June 3, 2002